

PATENT
Attorney Docket No. 52438.830008.US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Koch, Kevin

Examiner: Sain, Gautam

Serial No. 10/710,796

Art Unit: 2176

Filed: August 3, 2004

For: COMPUTER PROGRAM PRODUCT
CONTAINING ELECTRONIC
TRANSCRIPT AND EXHIBIT FILES AND
METHOD FOR MAKING SAME

APPEAL BRIEF

Honorable Commissioner of Patents and Trademarks
Alexandria, VA 22313

Sir:

This is an appeal from the decision of the Examiner mailed on June 29, 2007 finally rejecting claims 1-19 and 21-25.

REAL PARTY IN INTEREST

The real party in interest in this appeal is RealLegal, LLC, as evidenced by an Assignment filed at Reel 015967, Frame 0361.

RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences that are related to this case.

STATUS OF THE CLAIMS

Claims 1-19 and 21-25 remain in this application.

This appeal is taken from the final rejection of claims 1-19 and 21-25.

No claims are allowed.

STATUS OF AMENDMENTS

An Amendment and Response was filed on May 8, 2007 in response to a August 9, 2006 Office Action. The Examiner submitted a Final Office Action on June 29, 2007. An Amendment After Final Rejection was filed on September 12, 2007. In a September 25, 2007 Advisory Action, the Examiner stated that the September 12, 2007 Amendment would not be entered for purposes of appeal, alleging that the Amendment raised new issues.

SUMMARY OF CLAIMED SUBJECT MATTER

Claim 1 is an independent claim, from which claims 2-16 each ultimately depend. The preamble of claim 1 is directed to a method of producing a computer program product on a computer readable medium wherein the computer readable medium comprises electronic versions of transcripts with links operably connecting the electronic versions of transcripts with electronic versions of exhibits. (Page 3, lines 19-24; page 4, lines 1-7; page 5, lines 18-23; page 6, lines 1-16). Claim 1 recites the step of importing one or more electronic transcript files and one or more electronic exhibit files to a publisher. (Page 8, lines 18-24). In another step, claim 1 recites establishing an operable electronic link in at least one of the electronic transcript files between the at least one of the electronic transcript files and at least one of the electronic exhibit files. (Page 11, lines 14-24). Claim 1 further recites the step of writing the one or more electronic transcript files and the one or more electronic exhibit files with the established operable electronic link to at least one memory file on the computer readable medium. (Page 12, lines 2-6). Claim 1 also includes the step of providing a means on the computer readable medium to view the one or more electronic transcript files and the operably linked one or more electronic exhibit files. (Page 6, lines 20-24; page 7, 1-3, 8-12, 22-24; page 8, lines 1-17).

Claim 1 recites a means “on the computer readable medium to view the one or more electronic transcript files and the operably linked one or more electronic exhibit files”, which is a means plus function limitation pursuant to

35 U.S.C. § 112(6). Insufficient structure is disclosed within the limitation for performing the recited function of accessing the first and second deformation members to create at least first and second deformation cavities. Accordingly, the limitation must be construed under 35 U.S.C. § 112(6). Appellant's specification, at page 7, lines 22-24 and page 8, lines 1-17, identifies a number of exemplary embodiments that define the means as: "a viewer 26 or locally accessible viewer, associated with product 20 [that] provides a user controllable display of the electronic transcript 22 and the exhibits 24 associated therewith." It may be provided as one or more viewer modules.

Claim 17 is an independent claim, from which claims 18, 19 and 21-24 each ultimately depend. The preamble of claim 17 is directed to a computer program product stored in a computer readable medium. Claim 17 requires a computer readable medium including computer readable code embodied therein for processing data to provide an electronic transcript and at least one operable electronic link between the electronic transcript and the electronic exhibit. (Page 5, lines 19-24; page 6, lines 1-2). Claim 17 recites that the computer readable medium includes: an importing module configured to import one or more electronic transcript files and one or more electronic exhibit files (Page 10, lines 1-20); an association module configured to establish an operable electronic link in the one or more electronic transcript files to provide an operable electronic link between at least one of the one or more electronic transcript files and the one or more electronic exhibit files (Page 11, lines 14-24); a writing module configured to write the imported electronic transcript files and electronic exhibit files with the operable electronic link established by the association module to at least one memory file in the computer readable medium (Page 12, lines 2-6); and a viewing module in the computer readable medium configured to allow a user to view the at least one memory file. (Page 6, lines 20-24; page 7, 1-3, 8-12, 22-24; page 8, lines 1-17).

Claim 25 is an independent claim, from which no claims depend. The preamble of claim 25 is directed to an apparatus for providing a viewable electronic transcript and an associated electronic exhibit. Claim 25 recites at least one memory file in a computer readable medium and at least one processor (Page 6, lines 16-20). Claim 25 recites that the at least one memory file in the computer readable medium includes: one or more electronic transcript files; one or more electronic exhibit files; and at least one operable electronic link in the one or more electronic transcript files operably linking at least one of the one or more electronic transcript files and at least one electronic exhibit file of the one or more electronic exhibit files. (Page 11, lines 14-24) Claim 25 recites that the at least one processor includes: a reader to read the at least one memory file from the computer readable medium; and a viewer to display the at least one memory file, the viewer being configured to allow simultaneous display of the one or more electronic transcript and any operable electronically link electronic exhibits. (Page 6, lines 16-24; page 7, lines 1-13).

Claims 2-19 and 21-25 do not recite a means plus function limitation pursuant to 35 U.S.C. § 112(6).

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. The Examiner rejected claims 1-16 and 25 under 35 USC § 101, alleging the claims to be directed to non-statutory subject matter.

B. The Examiner rejected claims 1-19 and 21-25 under 35 U.S.C. § 102(a) as being anticipated by United States Patent Application Publication No. 2003/0078973 (“Przekop et al.”)

ARGUMENT

A. Claims 1-16 and 25 are patentable under 35 U.S.C. § 101.

The Examiner has rejected claims 1-16 and 25 under 35 USC § 101, alleging the claims to be directed to non-statutory subject matter.

Specifically, the Examiner states that “computer readable medium”, as used

within the claim limitations, may be read as a “carrier wave”, which is non statutory.¹ The appellant respectfully disagrees.

A carrier wave is commonly a waveform suitable for modulation by an information-bearing signal. Such a carrier is usually a sinusoidal wave or a uniform or predictable series of pulses. Claim 1 specifically modifies the term “computer readable medium”, stating that one required step of the claimed method includes “writing the one or more electronic transcript files and the one or more electronic exhibit files with the established operable electronic link to at least one memory file on the computer readable medium.” Carrier waves are not capable of being “written to” let alone storing electronic files with one or more links to separate memory files. The term is further narrowed when another step of the claimed method requires “providing a means on the computer readable medium to view the one or more electronic transcript files and the operably linked one or more electronic exhibit files.” Again, a carrier wave is incapable of use as the medium for carrying out such a limitation.

In the specification, the “computer readable medium” is defined by the examples of a local processor, a remote processor over a network connection, or an external media source such as a CDROM, a DVD, a magnetic disk, a tape drive or the like. Such examples are capable of fulfilling the claimed methodology, whereas a carrier wave simply is not.

Claim 1 specifically claims electronic files, viewer means and the like, associated with a computer readable medium, thus producing a “useful, concrete and tangible” result. Claims 2-16 each ultimately depend from claim 1 and are allowable for at least the reasons set forth herein with respect to claim 1.

¹ The Examiner suggested the term “computer readable medium” be changed to “computer readable storage medium” to avoid the present rejection. Applicant so amended the subject claim limitations in the September 12, 2007 Amendment After Final Rejection. However, the Examiner refused to enter the amendment for purposes of appeal despite the fact that such entry would have narrowed the scope of the present appeal.

Claim 25 similarly modifies the claim term, “computer readable medium”, at least to the extent that claim 25 is directed to an apparatus including “at least one memory file in a computer readable medium.” Carrier waves are not capable of performing as a host for memory files as they are not repositories for data storage. Moreover, the memory file within the computer readable medium includes “at least one operable electronic link in the one or more electronic transcript files operably linking at least one of the one or more electronic transcript files and at least one electronic exhibit file of the one or more electronic exhibit files.” Such limitations are not possible with carrier waves.

The rejection of claims 1-16 and 25 under 35 USC § 101 is believed to be inappropriate in view of the claimed limitations.

B. Claims 1-19 and 21-25 are patentable under 35 U.S.C. § 102(a) over United States Patent Application Publication No. 2003/0078973 to Przekop et al.

Przekop et al. teach a system that synchronizes electronic video/audio records and corresponding electronic transcripts of the video/audio records. Accordingly, the transcripts are simply the same information as the video/audio records, but in different file formats. Claims 1, 17 and 25 each are specifically related to operable electronic linking of “electronic transcripts” and “electronic exhibit files,” which are files containing different information.

Anticipation under 35 U.S.C. § 102 focuses on the questions of whether or not a claim reads on the product or process disclosed by a prior art reference, not what the reference broadly “teaches.” Kalman v. Kimberly-Clarke Corp., 713 F.2d 760 (Fed. Cir. 1983). “For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed function must be identically shown in a single reference.” Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675 (Fed. Cir. 1988); Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (A claim is anticipated only if each and every element as set forth in

the claim is found, either expressly or inherently described, in a single prior art reference).

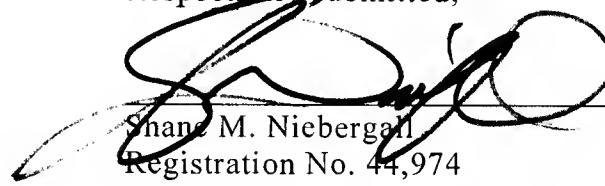
The differences between the system of the Przekop, et al. reference and appellant's claimed system are substantial and significant, as described herein. The Przekop, et al. reference teaches linking an audio or video record to a transcript of the record, whereas the present system links electronic transcripts with electronic exhibit files associated within the matter that was transcribed. This distinction is claimed specifically within claims 1, 17 and 25. Accordingly, claims 1, 17 and 25 are believed to be patentably distinct from the prior art. Claims 2-16 each ultimately depend from claim 1 and claims 18, 19, and 21-24 each ultimately depend from claim 17. Accordingly, the aforementioned dependent claims are believed to be allowable for at least the reasons set forth herein with respect to claims 1 and 17. As such the Examiner's rejections should be reversed.

Request:

Reversal of the Examiner's final rejection of claims 1-16 and 25, under 35 USC § 101, and claims 1-19 and 21-25, under 35 U.S.C. § 102(b) over the Przecop, et al. reference, is respectfully requested for the above-stated reasons.

Signed this 3rd day of January, 2008.

Respectfully submitted,


Shane M. Niebergall
Registration No. 44,974
ATTORNEY FOR APPELLANTS
HOLLAND & HART LLP
Post Office Box 8749
555 17th Street, Suite 3200
Denver, Colorado 80201
(303) 295-8034

CLAIMS APPENDIX

The Claims involved in this Appeal read as follows:

1. A method of producing a computer program product on a computer readable medium wherein the computer readable medium comprises electronic versions of transcripts with links operably connecting the electronic versions of transcripts with electronic versions of exhibits, the method performed on a processor comprising the steps of:

importing one or more electronic transcript files and one or more electronic exhibit files to a publisher;

establishing an operable electronic link in at least one of the electronic transcript files between the at least one of the electronic transcript files and at least one of the electronic exhibit files;

writing the one or more electronic transcript files and the one or more electronic exhibit files with the established operable electronic link to at least one memory file on the computer readable medium; and

providing a means on the computer readable medium to view the one or more electronic transcript files and the operably linked one or more electronic exhibit files.

2. The method of claim 1, wherein the writing step comprises writing to a portable computer readable medium device.

3. The method of claim 2, wherein the portable computer readable medium device comprises a magnetic disk, an optical disk, a tape, or a removable hard disk.

4. The method of claim 1, wherein the writing step comprises writing to the computer readable medium that comprises a local memory file accessible from a local processor.

5. The method of claim 1, wherein the writing step comprises writing to the computer readable medium that comprises a remote memory file accessible from a local processor.

6. The method of claim 5, wherein the remote memory file is accessible through a network.

7. The method of claim 6, wherein the network comprises at least one of a LAN, WAN, WLAN, Wi Fi network, Ethernet, Internet, World Wide Web, or an optical network.

8. The method of claim 1, further comprising the steps of:
establishing a network connection between the at least one memory file and a local processor; and
launching the provided means to view at the local processor.

9. The method of claim 1, wherein the step of establishing the operable electronic link comprises establishing a hyper-link from the at least one of the one or more electronic transcripts to at least one of the one or more electronic exhibits.

10. The method of claim 9, wherein the hyper-link is established in the at least one of the one or more electronic transcripts at a first reference to the at least one of the one or more electronic exhibits.

11. The method of claim 9, wherein the hyper-link is established in the at least one of the one or more electronic transcripts at all references to the at least one of the one or more electronic exhibits.

12. The method of claim 9, wherein the hyper-link is established in the at least one of the one or more electronic transcripts at one or more user defined link points to the at least one of the one or more electronic exhibits.

13. The method of claim 1, wherein the providing a means to view step provides a means to view the electronic transcript and the operable electronic linked electronic exhibit substantially simultaneously.

14. The method of claim 13, wherein the providing a means to view step further provides independent controls of the viewed electronic transcript and the operable electronic linked electronic exhibit.

15. The method of claim 1, further comprising the step of providing an interface to allow a user to select one or more electronic transcripts to view.

16. The method of claim 1, wherein the providing a means to view step provides means to view electronic exhibit files selected from a group of files consisting of: video, audio, video/audio, animation, MPEGS, still images, text files, TIF, PDF, JPG, bitmap, GIF format, and JPEGS.

17. A computer program product stored in a computer readable medium comprising:

a computer readable medium including computer readable code embodied therein for processing data to provide an electronic transcript and at least one operable electronic link between the electronic transcript and the electronic exhibit, the computer readable medium comprising:

an importing module configured to import one or more electronic transcript files and one or more electronic exhibit files;

an association module configured to establish an operable electronic link in the one or more electronic transcript files to provide an operable electronic link between at least one of the one or more electronic transcript files and the one or more electronic exhibit files;

a writing module configured to write the imported electronic transcript files and electronic exhibit files with the operable electronic link established by the association module to at least one memory file in the computer readable medium; and

a viewing module in the computer readable medium configured to allow a user to view the at least one memory file.

18. The computer program product of claim 17, wherein the writing module is configured to write to a file accessible to the computer readable medium over a network.

19. The computer program product of claim 17, wherein the writing module is configured to write the at least one memory file to a computer readable medium selected from a group of medium consisting of: a magnetic disk, and optical disk, a tape, a removable hard disk, a CDROM, or a DVD disk.

20. (canceled)

21. The computer program product of claim 17, wherein the viewing module is configured to view at least one of video, audio, video/audio, animation, MPEGS, still images, text files, TIF, PDF, JPG, bitmap, GIF format, and JPEGS.

22. The computer program product of claim 17, wherein the viewing module is configured to access the at least one memory file on the computer readable medium through a network connection.

23. The computer program product of claim 22, wherein the viewing module is configured to download the at least one memory file from the computer readable medium.

24. The computer program product of claim 22, wherein the viewing module is configured to stream the at least one memory file from the computer readable medium.

25. An apparatus for providing a viewable electronic transcript and an associated electronic exhibit, the apparatus comprising:

at least one memory file in a computer readable medium; and

at least one processor, wherein

the at least one memory file in the computer readable medium comprises:

one or more electronic transcript files;

one or more electronic exhibit files; and

at least one operable electronic link in the one or more electronic transcript files

operably linking at least one of the one or more electronic transcript files and at least one

electronic exhibit file of the one or more electronic exhibit files;

the at least one processor comprises:

a reader to read the at least one memory file from the computer readable
medium; and

a viewer to display the at least one memory file, the viewer being configured
to allow simultaneous display of the one or more electronic transcript and any operable
electronically link electronic exhibits.

EVIDENCE APPENDIX

Not applicable.

RELATED PROCEEDINGS APPENDIX

Not applicable.